



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/905,238      | 07/12/2001  | Shell Sterling Simpson | 10008180-1          | 3497             |

7590 07/03/2006

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

|          |
|----------|
| EXAMINER |
|----------|

SINGH, SATWANT K

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2625

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/905,238 | Applicant(s)<br>SIMPSON ET AL. |  |
|                              | Examiner<br>Satwant K. Singh  | Art Unit<br>2625               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-12, 14-26 and 28-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 28-30 is/are allowed.
- 6) ☒ Claim(s) 11, 12, 14, 15, 17-23 and 26 is/are rejected.
- 7) ☒ Claim(s) 16, 24 and 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on 10 April 2006.

### ***Response to Arguments***

2. Applicant's arguments, see amendment, filed 10 April 2006, with respect to claims 1 and 30 have been fully considered and are persuasive. The rejection of Davis et al. (US 2002/0059489) has been withdrawn.
3. Applicant's arguments with respect to claims 11, 14, and 15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

4. Claims 1-10, and 28-30 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter: Claims 1 and 30 of the current application teach similar subject matter as the prior art of Davis et al. (US 2002/0059489). However claims 1 and 30 are allowed for the reasons pointed out by applicant's remarks (page 8, 6<sup>th</sup> and 7<sup>th</sup> paragraphs, page 9 6<sup>th</sup> paragraph).
6. Claims 2-10, 28, and 29 are allowable for being dependent on an allowable base claim.
7. Claims 16, 24, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 11, 12, 14, 15, 17-23, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman et al. (US 6,707,574),

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

10. Regarding Claim 11, Freeman et al disclose a method, comprising: receiving a user-selection of print options associated with a print service accessible to a client computing device, wherein the print service represents an associated printer (the input device 12 communicates print job to the printer 14, in response to commands of a user) (col. 2, lines 27-29); storing, remotely from the client computing device, the user-selected print options along with a user-identified name for the print options (explicit attributes are stored in storage 22) (col. 3, lines 9-28); and subsequently receiving a

print request (stored print job attributes are accessed from storage 22 when a user desires to examine the print job prior to printing) (col. 3, lines 29-44) without print options and automatically selecting a set of print options to print a document identified in the print request (in response to a user selection of a job, the driver directs the printer to retrieve the selected job from storage into printer memory and print it) (col. 3, lines 29-44), wherein the set of print options are automatically selected based at least in part on one or more characteristics of the print request (stored print jobs and its associated attributes) (col. 3, lines 29-60, ) (Figs. 6 and 7).

11. Regarding Claim 12, Freeman et al disclose a method, further comprising allowing the receiving and storing without requiring a printer driver for a printer corresponding to the print service to be installed on the client computing device (another way of accessing print jobs) (col. 3, lines 50-60) (Fig. 7).

12. Regarding Claim 14, Freeman et al discloses a method comprising: receiving, from a client computing device, a request to print an image and an identifier of a set of print options (input device 12 communicates a print job to the printer 14, in response to commands of a user) (col. 2, lines 27-29); and accessing a location other than the client computing device to obtain the identified collection of printer configuration options (stored print job attributes are accessed from storage 22 when a user desires to examine the print job prior to printing) (col. 3, lines 29-44) wherein the print options are automatically identified based at least in part on one or more characteristics of the request (stored print jobs and its associated attributes) (col. 3, lines 29-60, ) (Figs. 6 and 7).

13. Regarding Claim 15, Freeman et al disclose a method comprising: receiving a print request identifying a document to be printed (in response to a user selection of a job, the driver directs the printer to retrieve the selected job from storage into printer memory and print it) (col. 3, lines 29-44); and automatically selecting, based at least in part on one or more characteristics of the print request, a set of print options to be used when printing the document (based on the collected attributes, the order in which the stored print jobs should be printed) (col. 3, lines 61-67, col. 4, lines 1-15) (Fig. 8).

14. Regarding Claim 17, Freeman et al disclose a method, wherein receiving the print request comprises receiving the print request at a printer (the input device 12 communicates print job to the printer 14, in response to commands of a user) (col. 2, lines 27-29).

15. Regarding Claim 18, Freeman et al disclose a method, wherein receiving the print request comprises receiving the print request at a print service associated with a printer (software routines to store or access print job attributes) (col. 3, lines 29-60).

16. Regarding Claim 19, Freeman et al disclose a method, wherein automatically selecting the set of print options comprises identifying a print option configuration by name that includes the set of print options (stored print job) (Fig. 3, explicit print job attributes).

17. Regarding Claim 20, Freeman et al disclose a method, wherein the characteristics comprise at least one or more characters in a name of the document stored print job) (Fig. 3, explicit print job attributes).

18. Regarding Claim 21, Freeman et al disclose a method, wherein the characteristics comprise at least a size of the document stored print job) (Fig. 3, explicit print job attributes, media size).

19. Regarding Claim 22, Freeman et al disclose a method, wherein automatically selecting the set of print options comprised comparing the characteristics to a set of rules that map characteristics to print options (based on the collected attributes, the order in which stored print jobs should be printed) (col. 3, lines 61-67, col. 4, lines 1-15) (Fig. 8).

20. Regarding Claim 23, Freeman et al disclose a method, wherein the set of rules comprises at least one user-defined rule (stored print jobs with fewer than a certain number of pages) (col. 3, lines 61-67, col. 4, lines 1-15).

21. Regarding Claim 26, Freeman et al disclose a method, further comprising allowing the user to override the automatically selected print options (user desires to examine the print job prior to printing) (col. 3, lines 29-31).

### ***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Matsubayashi et al. (US 6,938,202) disclose a system for retrieving and printing network documents.

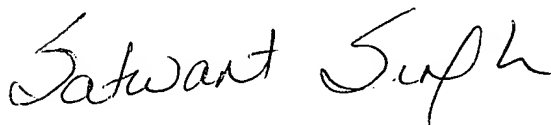
Miura et al. (US 2005/0024677) disclose a network print system printing data generated using a web browser of a client.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

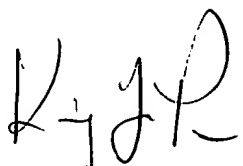
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



sks

Satwant K. Singh  
Examiner  
Art Unit 2625



KING Y. POON  
PRIMARY EXAMINER